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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/636,125 | 08/07/2003 | Robert B. Phelps | S-816 | 1568 |
| 2071 7590 07/02/2009 McGLINCHEY STAFFORD, PLLC Attn: IP Group 301 Main Street, 14th Floor BATON ROUGE, LA 70802 | | | | |
| EXAMINER | | | | |
| FRENEL, VANEL | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3687 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 07/02/2009 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/636,125

Applicant(s)

PHELPS, ROBERT B.

Examiner

VANEL FRENEL

Art Unit

3687

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 23-26 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 23-26 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date 20090604
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/04/09 has been entered.

Notice to Applicant

2. This communication is in response to the RCE filed on 6/04/09. Claims 1, 24, 25 have been amended. Claim 28 have been newly added. Claims 1-4, 23-26 and 28 are pending.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 26 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 26 recites the limitation of "administering the pension plan on an approximately regular basis to perform the investing and calculating steps to thereby reduce an unfunded actuarial accrued liability (UAL) **and/or** reduce any corresponding

UAL amortization". The claim contains the term "or". The term renders the claim indefinite, since it is not possible to determine the scope of the claim as requiring both items separated by the "or". For purposes of examination, the Examiner will give the term its broadest reasonable interpretation and consider that the particular condition is satisfied if one of the limitations is met.

6. Claim 28 recites the limitation of "the method according to claim 1, wherein a first party performing the method contracts with **or** directs one or more third parties to perform by a computing apparatus one or more of the steps of claim 1. The claim contains the term "or". The term renders the claim indefinite, since it is not possible to determine the scope of the claim as requiring both items separated by the "or". For purposes of examination, the Examiner will give the term its broadest reasonable interpretation and consider that the particular condition is satisfied if one of the limitations is met.

Allowable Subject Matter

7. Claims 26 and 28 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

8. Claims 1-4, 23 and 25 are allowable. The following is an examiner's statement of reasons for allowance.

Claim 1 is directed to "determining, by the computing apparatus, a total value of pension plan assets, including the actuarial present value of the plurality of life settlement contracts, with the total value of the pension plan assets inclusive of the

ownership interest in the selected plurality of current, in-force life settlement contracts so acquired converting a value of the assets of the pension plan used to acquire the ownership interest in the selected plurality of current, in-force life settlement contracts into an actuarial present value of the ownership interest in the selected plurality of current, in-force life settlement contracts; calculating, by the computing apparatus, a difference between the total value of the pension plan assets and liabilities of the pension plan to obtain an unfunded actuarial accrued liability; and maintaining enforceability of the selected plurality of current, in-force life settlement contracts and processing death benefits arising from the life settlement contracts".

The closest prior art of record: Brisbois et al. (2005/0216316) discloses capital market products including spia securitized life settlement bonds and method of issuing, servicing and redeeming same.

Halley et al. (4,969,094) discloses self-implementing pension benefits system.

However, none of the cited prior art teaches "determining, by the computing apparatus, a total value of pension plan assets, including the actuarial present value of the plurality of life settlement contracts, with the total value of the pension plan assets inclusive of the ownership interest in the selected plurality of current, in-force life settlement contracts so acquired converting a value of the assets of the pension plan used to acquire the ownership interest in the selected plurality of current, in-force life settlement contracts into an actuarial present value of the ownership interest in the selected plurality of current, in-force life settlement contracts; calculating, by the computing apparatus, a difference between the total value of the pension plan assets

and liabilities of the pension plan to obtain an unfunded actuarial accrued liability; and maintaining enforceability of the selected plurality of current, in-force life settlement contracts and processing death benefits arising from the life settlement contracts", as recited in independent claim 1 above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VANEL FRENEL whose telephone number is (571)272-6769. The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Gart can be reached on 571-272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Vanel Frenel/
Examiner, Art Unit 3687
June 19, 2009